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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	004528.P001	1291

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EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2171

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/520,264

Applicant(s)
Weaver et al.

Examiner
Te Chen

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2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 5, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Response to Amendment

1. This is in response to amendment filed on 08/05/2002 (paper # 10).
2. Claims 1-34 remain for examination, claims 1-2, 4-30, 33-34 have been amended.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, applicant's original specification fails to disclose the "third- party electronic files" as recited in every independent amended claim. Furthermore, applicant's original invention is for electronic legal documents accessing and processing on a network system, however, the amended claims enlarge the invention scope to "electronic files" from narrower "legal documents" without disclosing the supporting technique as how to

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converge different formats of "electronic files" into electronic legal documents for processing.

Thus, all the amended claims are rejected.

5. As to the rest dependent claims, these claims have the same defects as their base claims, hence were rejected for the same reasons.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Beck et al. (U.S. Patent. No. 6,332,154).

8. As to claim 17, Beck et al. (Thereinafter referred as Beck) disclosed a network node, comprising: a server couple to a database system, wherein the database system having indexed electronic documents and electronic characteristics of the documents format, such that the server will use the stored information to search for electronic documents matching user's query and

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provide search results to the user [57, 75, 77, 79, Fig. 1; col. 10, lines 16-20; col. 11, lines 13-25; Fig. 12, Fig. 13].

9. As to claim 18, in addition to all features of claim 17, Back further disclosed that the server stores user-input information associated with representations of electronic documents [col. 10, lines 34-40; 287, Fig. 14; col. 34, lines 50-54].

10. As to claim 19, in addition to all features of claim 17, Back further disclosed that the electronic documents comprise E-mail messages having threading information [Fig. 8; col. 6, lines 53-56].

11. As to claim 20, Back disclosed the claimed system substantially comprising:
a conversion engine to convert electronic legal documents into a database format [col. 10, line 62 - col. 11, line 7; col. 22, lines 10-14]; and
a server coupled to the conversion engine and communicatively coupled to a database system, wherein the server capable of using the indexing information and the electronic characteristics to provide search results to the user node in responsive to the search query [77, 79 Fig. 1; col. 10, lines 23-33; col. 11, lines 29-30; 51-53].

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12. As to claim 21, in addition to all features of claim 20, Back further disclosed that the system will load the electronic legal documents into database system, comprising:

recursive search engine to recursively extracting a plurality of electronic documents provided from a source [109, 113, Fig. 3; multimedia search engines, col. 50, lines 1-15];

controller coupled to the recursive engine to identify a plurality of objects having different data formats for each of the extracted electronic documents via the electronic characteristics [97, Fig. 3; Database Access Module (DAM), col. 28, lines 30-33];

an upload unit coupled to the controller to store data associated with the identified objects in a first location in the database system [col. 10, lines 51-59; col. 55, lines 19-33];

a converter to convert the other identified objects and storing data associated with the converted objects in a second location in the database system [253, Fig. 12; col. 10, lines 23-31];
and

the data stored in the first and second locations are indexed [col. 11, lines 51-53] .

13. As to claim 22, in addition to all features of claim 20, Back further disclosed that a first server unit to store indexing information associated with text context of the electronic documents [79, Fig. 1; 75, Fig.1]; and a second server unit to store indexing information associated with metadata content of the electronic documents [57, Fig. 1; 275, Fig. 12].

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14. As to claims 23-30 and 33, these claims recited the same limitations as claims 17-22 in form of machine-readable medium product or network node, hence were rejected for the same reasons.

15. As to claims 1-16, 31-32 and 34-49, the steps in the claimed method are deemed to be made inherit by the functions of the apparatus structure of claims 17-22, in the combination discussed above, hence were rejected for the same reasons.

Response to Arguments

16. Applicant's arguments filed on 08/05/2002 have been fully considered but they are not persuasive.

17. Regarding Applicant's arguments with respect to the 102 rejections, the examiner disagrees with applicant's assertion that the prior art on record including Beck, fails to disclose or suggest: "the technology to process third-party communication between Customers A-D or other parties with which it has no direct interaction".

18. In response, the examiner points out that the third-party communication between Customers A-D or other parties are not disclosed in the original specification, they are considered new matter and rejected under U.S. Code 112, First paragraph as discussed above. Furthermore,

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Beck specifically disclosed that his invention comprising a media-independent self-help modules with customer interface to enable the enterprise to keep track of potential and existing customers, and to directly [i.e., initiated by the user] or indirectly [i.e., initiated by Beck's system] interact with selected media options for new customers, existing customers and business associates [see Title; col. 4, lines 52-63]. Thus, the examiner maintains the original rejection.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are: (703) 746-7238 (After Final Communication); (703) 746-7239 (Official Communications); and (703) 746-7240 (For Status Inquiries, Draft Communication).

22. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Oct. 15, 2002


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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